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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,805	12/31/2003	Braulio A. Polanco	17,315.1	5348

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EXAMINER	
PIERCE, JEREMY R	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/749,805	POLANCO ET AL.	
	Examiner	Art Unit	
	Jeremy R. Pierce	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22,24-38,40-46,48 and 49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22,24-38,40-46,48 and 49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on May 25, 2005 has been entered. Claims 23, 39, and 47 have been cancelled. Claims 6-9, 20-22, 24-34, 40-42, 46, 48, and 49 have been amended. Claims 1-22, 24-38, 40-46, 48, and 49 are currently pending. The amendment is sufficient to overcome the 35 USC 112 2nd paragraph rejections to claims 6-9, 24-34, 40-42, 46, 48, and 49 set forth in section 4 of the last Office Action because these claims have been amended to be in Markush form. However, all other rejections set forth in the last Office Action are maintained for the reasons set forth below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-9, 20-22, 24-38, 40-46, 48, and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

These claims recite various formation index values for either the top side or the wire side of the web, based on the bulk value or the basis weight of the web. However,

the specification does not teach a person of ordinary skill in the art how formation index correlates with the bulk of the web, nor does the specification teach how the formation index correlates with the basis weight of the web. For example, claim 9 recites the web has a formation index averaging above 31.6 on the wires side when the basis weight is about 6.0 osy. Then it recites the formation index raises to above 37.09 when the web weighs 2.5 osy. But then the claim states that the formation index falls to above 35.03 when the web weighs 2.25 osy. There is no discernable trend between these values, and the specification does not teach a person of ordinary skill in the art why a web, when it has a certain weight (or bulk), would then have the claimed formation index values on the wire side or top side. Why are these differing results achieved? How is the web made in order to arrive at these values? Similar analysis applies for the other rejected claims.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-5, 20-22, 35-38, and 43-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims recite various formation index values for either the top side or the wire side of the web, based on the bulk value or the basis weight of the web. However, it is unclear how a nonwoven material can have two or more different bulk values or two or more different basis weights. For example, claim 2 recites the web has a formation index above 37.6 when the web has a bulk of to about 0.1 inches, but the same claim

also recites the web has a formation index above about 32.03 when the web has a bulk of over about 0.1 inches. How can a fabric have two different bulk values? Similar analysis applies for the other rejected claims.

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-15, 19-22, 24-30, 34-38, 40-46, 48, and 49 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pike et al. (U.S. Patent No. 5,382,400).

Pike et al. teach a nonwoven web made of continuous bicomponent filaments that are crimped (Abstract). Although Pike et al. does not explicitly teach the limitations concerning formation index, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. spunbonded bicomponent filaments) and in the similar production steps (i.e. crimping in a manner that forms a more uniform surface) used to produce the nonwoven

fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed formation indices would obviously have been provided by the process disclosed by Pike et al. because Pike et al. teach the crimping step forms a stable and uniform fabric with high loft (column 3, lines 20-26). Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. The basis weight of the fabric may range from 0.25 to 5 osy (column 9, line 57).

With regard to claims 10-15 and 27-30, the Examples in Tables 1-9 show deniers within Applicant's claimed ranges. With regard to claims 19 and 34, Pike et al. teach the fabric is through-air bonded (column 9, line 47).

Claim Rejections - 35 USC § 103

9. Claims 16-18 and 31-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Pike et al. in view of Sudduth et al. (U.S. Patent No. 5,770,531).

Pike et al. do not disclose adding titanium dioxide to the fibers. Sudduth et al. teach that titanium dioxide is often added to fibers in an amount of 2% by weight in absorbent products in order to provide a white coloring (column 4, lines 2-4). It would have been obvious to a person having ordinary skill in the art at the time of the invention to add 2% titanium dioxide to the fibers of Pike et al. in order to provide white coloration to the absorbent product, as taught by Sudduth et al.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-57 of copending Application No. 10/749,461. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to continuous bicomponent crimped fibers with the similar properties of formation index. Both sets of claims contain similar weights and bulk values, along with the same denier values for the fibers and amount of titanium dioxide provided for color.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

12. Applicant's arguments filed May 25, 2005 have been fully considered but they are not persuasive.

13. Applicant argues that the claims are enabled because the person having ordinary skill in the art is given the necessary information for understanding and practicing the claimed inventions by the present specification. The Examiner disagrees. The specification does not adequately teach what steps are needed to create a nonwoven fabric comprising a web that will attain the claimed formation index values at the various claimed bulk values and basis weights. While a person of ordinary skill in the art is capable of producing a web with a particular basis weight or bulk value, a person of ordinary skill in the art would not know how to correlate Applicant's claimed formation index values to the particular basis weights or particular bulk values. Applicant asserts that there is no statutory requirement within § 112 for discernible trends within a patent application or a claim; or required explanations of why an invention functions to meet the limitations of a claim; or requirements of predictability in the description and claims of an invention. However, the enablement rejection is still upheld because the specification does not teach one skilled in the art how to manufacture the claimed product. Additionally, the suggestion of discernable trends comes from Applicant's Specification. For instance, at page 30, lines 3, 8, and 12, Applicant specifically states that formation index values should follow "trends witnessed in the data." However, the claimed values do not follow any trend, despite Applicant's assertion in the Specification. This only serves as additional evidence that a person of ordinary skill in the art would be unable to practice this invention. Whether a trend is required by § 112 of the Statute or not, the lack of a trend with the claimed values is indicative that the values are merely random numbers created by chance. If this were so, then it would be

difficult for a person of ordinary skill in the art to practice the claimed invention with any certainty. Thus, the claims are not considered enabled to one of ordinary skill in the art.

14. Applicant argues that inherency is not present because no sufficient similarity in process can reasonably be attributed to Pike in comparison to the present invention. However, Pike teaches crimping in a manner that forms a more uniform surface (Abstract). This is direct evidence that the web of Pike is made with the claimed formation index values because formation index values are a measure of uniformity. The burden shifts to Applicant to overcome this presumption. Although Applicant asserts that Pike uses a Hot FDU production, this does not overcome the presumption that Pike meets the claimed limitations because the claims are only concerned with formation index values. There is no recitation in the claims as to any production method of the fibers. The Examiner is only concerned with limitations that are found in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on normal business hours, but works flextime hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRP

Jeremy R. Pierce
August 2, 2005

ELIZABETH M. COLE
PRIMARY EXAMINER